

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. With this amendment, claim 1 has been amended, no claims have been cancelled, and no claims have been added. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Thus, claims 1-8, and 10-30 are pending in the application, with claims 17-30 withdrawn.

Claim Rejections-35 U.S.C. § 112

Claim 2 was rejected under 35 U.S.C. § 112, second paragraph being indefinite for a lack of antecedent basis for the phrase “template nucleic acid into each chamber.” Applicant respectfully traverses this rejection.

It is the Examiner’s position that claim 1 “is drawn to labeled proteins, polypeptides or peptides, not to template nucleic acid.” (Advisory action, p.2, 3rd full paragraph). Further, it appears to be the examiner’s position that new elements cannot be introduced in dependent claims – that is, all recited elements must “already exist in claim 1.” (Advisory action, p.2, 3rd full paragraph). First, Applicants note the claim 1 is not drawn to “labeled proteins, polypeptides or peptides,” as alleged by the Examiner. Claim 1 is a process which comprises several steps that include, *inter alia*, labeled proteins, polypeptides or peptides. Further, Applicants do not know of, nor has the Examiner cited any statute, rule, or case that supports the proposition that all elements recited in a claim set must first be recited in the independent claims. Applicants note it is standard practice to sequentially add more features claims by way of dependent claims to provide claims of varying scope.

The Examiner appears to be questioning the enablement of the recited methods. Applicants note, however, that if the Examiner is unclear as to the operation of the claimed method, the rejection should be drawn to enablement, not a lack of antecedent basis for sequentially introduced features.

Applicants submit that claim 2 does not suffer a lack of antecedent basis and respectfully requests withdrawal of the rejection.

Claim Rejections-35 U.S.C. § 102

Claims 1, 4-5, 7-8, 10-14 and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by Chan EY (US Patent No. 6,210,896). Claims 1, 4-5, 7-8, 10-14 and 16 were rejected under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(a) as being anticipated by Chan EY (US Patent No. 6,355,420). Applicants respectfully traverse this rejection.

Neither Chan '896 nor Chan '420 anticipates claims 1, 4-5, 7-8, 10-14 and 16 because neither reference teaches all of the recited features of the claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Independent claim 1 has been amended to recite, *inter alia*, "an inner surface of the nanopores coated with a semiconductor material." Support for this feature can be found in at least paragraph [0097] of the specification. Neither Chan '896 nor Chan '420 teach "an inner surface of the nanopores coated with a semiconductor material" as recited in amended claim 1. Indeed, a word search of both Chan '896 nor Chan '420 shows that neither reference even uses the word "semiconductor," much less teach "an inner surface of the nanopores coated with a semiconductor material." Thus, neither Chan '896 nor Chan '420 anticipated independent claim 1 or any of the claims that depend on independent claim 1.

Claim Rejections-35 U.S.C. § 103

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chan EY (US Patent No. 6,210,896) as applied to claims 1, 4-5, 7-8, 10-14 and 16 above. Claims 2, 6, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan EY (US Patent No. 6,210,896) as applied to claims 1, 4-5, 7-8, 10-14 and 16 above in view of Thompson et al (US Patent No. 5,324,637). Applicants respectfully traverse this rejection.

As discussed above, independent claim 1 has been amended to recite, *inter alia*, “an inner surface of the nanopores coated with a semiconductor material.” This feature is neither taught nor suggested by Chan ‘896, Chan ‘420, or Thompson. Indeed, Thompson doesn’t even teach the use of nanopores.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: August 18, 2008

Respectfully submitted,

By /Martin Sulsky/
Martin Sulsky
Registration No.: 45,403
DARBY & DARBY P.C.
1500 K Street, NW
Suite 250
Washington, DC 20005-1714
(202) 347-7865
(202) 347-7866 (Fax)
Attorneys/Agents For Applicant